

## REMARKS

### I. Introduction

Applicants respectfully acknowledge the PTO's Notice in reply to Applicants' request for pre-appeal review filed September 2, 2005. Upon further consideration of the merits of the outstanding issues in this application, Applicants now request continued examination and reconsideration of the present application in view of the following.

### II. Status of the Claims

Claims 1-21 are pending. The PTO indicated in the Notice that Applicants' previously requested amendments, filed on July 5, 2005, are entered. No further claim amendments are requested at present.

### III. Rejection of Claims Under 35 U.S.C. § 103

#### A. Ground for Rejection

The sole issue in this application is the rejection of claims 1-21 under 35 U.S.C. § 103(a) over U.S. Pat. No. 5,656,286 to Miranda *et al.* ("Miranda '286") in view of U.S. Pat. No. 5,474,783 to Miranda *et al.* ("Miranda '783"), further in view of U.S. Pat. No. 5,230,898 to Horstmann *et al.* ("Horstmann"). The PTO relied upon Miranda '286 chiefly for its disclosure of a transdermal delivery system comprising a blend of at least two polymers, and upon Miranda '783 for its disclosure of certain polymers that allegedly give rise to a pressure-sensitive polymer blend. The PTO concluded that a person of ordinary skill in the art, armed with both references, would be motivated "to use different polymers combinations" to make Applicants' invention. Final Office Action at page 4. The PTO relied upon Horstmann for its teaching of pressure-sensitive properties of a transdermal drug delivery composition. Applicants respectfully traverse the rejection because the cited combination of references do not render obvious the claimed invention.

**B. Miranda '286 and '783 Are Not Prior Art, and Horstmann  
Alone Fails to Render Obvious the Claimed Invention**

**1. The Miranda Patents Are Unavailable as Prior Art**

As an initial matter, the PTO should acknowledge that neither Miranda '286 nor Miranda '783 are prior art. Section 103(c) provides that

[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This section of the patent statutes applies here, and prevents the Miranda patents from being cited against the instant application.

The cited Miranda patents relate to “subject matter developed by another person” because they name Miranda and Sablotsky as inventors while the present application names Mantelle and Houze. Moreover, the cited Miranda patents qualify as prior art only under §102(e) because they were published after the filing date of the instant application, but possess earlier filing dates. Finally, the Miranda patents and the subject matter of the presently claimed invention were both owned by NOVEN PHARMACEUTICALS, INC. at the time of the claimed invention. Thus, all of the requirements of § 103(c) are satisfied, and Miranda '286 and Miranda '783 are excluded as prior art.

**2. Horstmann Alone Fails to Render Obvious the Invention**

With the removal of the Miranda patents as prior art, the PTO's ground for rejection is supported only by the secondary reference Horstmann, which is incompetent for the following reasons. Horstmann does not teach or suggest high shear resistant acrylic-based polymer as required by each of Applicants' claims. Additionally, Horstmann fails to disclose the requisite low molecular weight and liquid drug.

Apparently to compensate for these fundamental differences between Horstmann and the claimed invention, the PTO repeatedly has attempted to manufacture motivation to modify Horstmann by simply stating that a person would be motivated to make Applicants' invention. *See, e.g.*, Final Office Action at page 6. Such bald assertions, without more, fall short of the standard required of an analysis under section 103(a).

For these reasons, and all of the previous reasons argued by Applicants, Applicants respectfully urge the PTO to reconsider and withdraw the obviousness rejection.

#### IV. Conclusion

Having eliminated the sole issue remaining in this application, Applicants respectfully request the PTO to favorably reconsider the application.

If there are any questions regarding this submission, or if any issues remain, the Examiner is invited to contact the undersigned by telephone in order to advance prosecution.

Respectfully submitted,

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The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.